

Attorney Docket No: 20423-10523
Client Ref: 200105140000
USSN: 09/855,073

REMARKS

STATUS OF THE CLAIMS

Claims 1-10, 12, 21-23, 43-45, and 48-53 were pending in this application. Rejections are still pending for claims 1-10, 43-45, and 48-53. Claims 12 and 21-23 have been allowed. Claims 43 and 48-53 have been cancelled. Claims 1, 10, 44, and 45 have been amended. Following entry of the amendments, claims 1-10, 12, 21-23, 44, 45 will be pending and at issue.

ALLOWED CLAIMS

Applicants acknowledge with appreciation the Examiner's indication that claims 12 and 21-23 are allowed. Office Action, p. 9.

ALLOWABLE SUBJECT MATTER

Applicants again acknowledge with appreciation the Examiner's statement that claims 43-45 would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. The Examiner also indicated in this Office Action that these claims must be rewritten to overcome the rejection(s) under 35 U.S.C. 112, 1st paragraph. Office Action, p. 9. In the previous Office Action of November 2, 2005, the Examiner indicated that such claims (claims 43-45) would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims (there was no pending rejection regarding 35 U.S.C. 112, 1st paragraph for those claims at that time). Office Action of November 2, 2005, p. 10. Thus, Applicants have amended claim 1, as written at the time of the Office Action of November 2, 2005, to incorporate all of the elements of claim 43. Elements of claim 1 that were added in the subsequent amendment and that the Examiner has indicated led to the rejection under 35 U.S.C. 112, 1st paragraph have been removed in the interest of expediting prosecution. Similar amendments were made to independent claim 10. Thus, the only amendments made to claims 1 and 10 are amendments to bring these claims back into their prior state before the November 2, 2005 Office Action and the addition of the limitations of claim 43. Therefore, since the Examiner indicated these claims (as written before the prior Office Action

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plus the limitations of claim 43) would be allowable without having to overcome any further rejections, Applicants respectfully request allowance of claims 1 and 10, and all claims depending therefrom (claims 2-9, 44 and 45).

SPECIFICATION

The Examiner objected to the specification as "failing to provide proper antecedent basis for the claimed subject matter." The Examiner objected to the language "...each candidate isomorph code functioning in substantially the same manner as...." The Examiner stated that the "specification only teaches to code that is functionally isomorphic...which does not necessarily function in substantially the same manner." Office Action, p. 3. However, Applicants respectfully note that the notion of functioning in substantially the same manner is disclosed throughout the application as filed. For example, the specification states specifically that "[o]nce the isomorphic instructions have been substituted for original instructions (step 120), the resulting code polymorph 20 is physically different from the original compiled executable 10, yet has substantially the same operational and functional characteristics." Specification, pg. 11, paragraph [0048]; *see also* pg. 12, paragraph [0050] ("...produces substantially the same functional result..."); pg. 13, paragraph [0052] ("...physically different instructions, but substantially the same functional characteristics of any other code polymorph 20") and ("...produce substantially the same functional result); pg. 16, paragraph [0061] ("In one exemplary aspect, the overall function of the application is substantially the same..."). Thus, the concept of functioning in substantially the same manner is disclosed throughout the application as filed. Therefore, Applicants respectfully request withdrawal of this objection.

REJECTIONS UNDER 35 U.S.C 112, FIRST PARAGRAPH

Claims 1-10, 43-45 and 48-53 are rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the written description requirement. The Examiner stated that "Applicant's original disclosure only teaches to the use of code that is functionally isomorphic, rather than code that functions in substantially the same manner, as is being recited in each of the

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independent claims.” As explained above, the concept of functioning in substantially the same manner is disclosed throughout the application, as originally filed. Therefore, Applicants respectfully request withdrawal of this rejection.

REJECTIONS UNDER 35 U.S.C. § 103

Claims 1-4 and 6-10 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over WIPO Patent Publication No. 99/01815 to Collberg et al. in view of U.S. Patent No. 6,480,959 to Granger. Claims 1 and 5 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,696,822 to Nachenberg in view of U.S. Patent No. 6,480,959 to Granger et al. In view of the amendments to the claims, these rejections have been rendered moot.

Claims 48, 49, and 51-53 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,006,328 to Drake further in view of U.S. Patent No. 6,480,959 to Granger et al. Claim 50 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,006,328 to Drake in view of U.S. Patent No. 6,480,959 to Granger et al as applied to claim 48 further in view of U.S. Patent No. 5,966,450 to Hosford et al. Claims 48-53 have been cancelled in the interest of expediting prosecution and allowance of the remaining claims. Applicants reserve the right to later pursue any cancelled or withdrawn claims.

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CONCLUSION

Withdrawal of the pending rejections and reconsideration of the claims are respectfully requested, and a notice of allowance is earnestly solicited. If the Examiner has any questions concerning this Response, the Examiner is invited to telephone Applicant's representative at (650) 335-7185.

Respectfully submitted,
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